

**Response**

Applicant: Daniel J. McGurran et al.

Serial No.: 09/872,532

Filed: June 1, 2001

Docket No.: M120.221.101 / 56763US002

Title: COLOR STABLE PIGMENTED POLYMERIC FILMS HAVING DYES FOR COLOR ADJUSTMENT**REMARKS**

The following remarks are made in response to the Final Office Action mailed March 23, 2006. In the Final Office Action, claims 26 and 27 were rejected under 35 U.S.C. § 112, first paragraph. In addition, claims 1, 2, 10, 11, 13-19, 21, 24, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by McGurran et al., U.S. Patent No. 6,569,517 ("McGurran"), and claims 22 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over McGurran in view of Weaver et al., U.S. Patent No. 6,248,816 ("Weaver").

With this Response, claims 1, 2, 10, 11, 13-19, and 21-27 remain pending in the application and are presented for consideration and allowance.

**Claim Rejections under 35 U.S.C. § 112**

Claims 26 and 27 were rejected under 35 U.S.C. § 112, first paragraph. The Final Office Action at page 2 takes the position that claims 26 and 27 include subject matter that was not disclosed in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed subject matter at the time the application was filed. In particular, the Examiner states: "Claims 26 and 27 are directed to window films having a specific composition and a specific thickness, i.e., the original disclosure does not teach a **window film** of a cast, oriented poly-ester containing polymer **having a thickness of 0.3 to 3 mm and having dispersed therein between 0.2 and 0.5 weight percent carbon black particular pigment . . .**" (Emphasis in the original). Applicant respectfully disagrees.

As a foundational matter, Section 112, first paragraph, provides:

The Specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same . . .

35 U.S.C. § 112, first paragraph.

With respect to the enablement requirement of Section 112, first paragraph, the Court of Appeals for the Federal Circuit has held that the specification is not to be written as a comprehensive tutorial, but is rather written for persons familiar with the relevant field; the

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applicant is not required to include in the specification information that is readily understood by practitioners. *Verve LLC v. Crane Cams Inc.*, 311 F.3d 1116, 65 USPQ2d 1051, 1053-54 (Fed. Cir. 2002). Satisfying the enablement requirement of Section 112, first paragraph, requires nothing more than objective enablement. *Staehelin v. Secher*, 24 USPQ2d 1513, 1516 (B.P.A.I. 1992). In fact, the Board's position is that the enablement requirement sets a relatively low threshold:

In satisfying the enablement requirement, an application need not teach, and preferably omits, that which is well known in the art . . . How such a teaching is set forth, whether by the use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims must be taken as complying with the first paragraph of 35 U.S.C. 112 unless there is reason to doubt the objective truth of the statements relied upon for enabling . . .  
*Id.*

With the above tenets in mind, the pending application describes various color stable optical bodies in the form of films (e.g., page 5, lines 5-17), and that the optical bodies can be used to tint automotive or window glazings (e.g., page 15, lines 12-22). Further, claim 21 (as set forth in the application as filed) described that the claimed optical bodies can be laminated to a window. In other words, the specification teaches that any of the disclosed optical bodies can be provided as optical films (single or multi-layer films), and that any of the disclosed optical bodies can be used to tint windows. The Examiner does not dispute that the compositional limitations of claim 26 and 27 are taught in the specification. Thus, because the specification enables an optical body or a film having the attributes of claims 26 and 27, as well as optical bodies or films being provided as window films, objective enablement under the Board's decision in *Staehelin* and requirements of Section 112, first paragraph are met.

In addition to the at least inherently, enabling teachings described above, Applicant respectfully notes that the test for enablement under 35 U.S.C. §112, first paragraph, is "whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217-1223 (Fed. Cir. 1988). "A considerable amount of experimentation is permissible, if it is merely routine, or if the

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specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed.” *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Based upon this and other Federal Circuit guidance related to satisfying the enablement requirement, it is respectfully asserted that the specification (e.g., Examples, Masterbatch/Film Processing descriptions, and Test Methods set forth in the specification from pages 15-22) enables one of skill in the art to make or use the window films of claims 26 and 27 without undue experimentation. That is to say, the specification clearly teaches the compositional limitations of claims 26 and 27, as well as to forming an optical body or film in accordance with these constraints. Because formation of a “window film” as an optical body or film subset is also known or at least readily understood by one of skill, no undue experimentation is required to make the claimed window film, such that Section 112, first paragraph, is satisfied.

With respect to the comments raised by the Examiner, the specification at page 1, line 14 teaches that tinted polymeric films can be applied to a base transparent substrate such as a window or auto glass pane to provide a neutral color tint to the window or auto glass pane. The Examiner takes the position that the specification at page 1, line 14 merely discusses the previous art. Applicant respectfully submits that discussions of previous art is relevant to satisfaction of the enablement requirement of Section 112, first paragraph, and further notes that the disclosure may even be supplemented by reference to other information and other patents, which are by their nature “previous art.” See, *In re Howarth*, 654 F.2d 103, 210 USPQ 689, 692-93 (C.C.P.A. 1981). To this end, applying a tinted polymer film to a window is known, and in this context, “window film” is simply an understood subset of “tinted polymer films.” Since the films described in the specification are tinted polymer films, one of skill in the art would thus understand that this inherently teaches a “window film.”

Additionally, the specification teaches at page 4, line 18: “Still further, the present disclosure provides articles, including pigmented window and auto glass films, that incorporate the above color-stable optical bodies.” The Examiner takes the position in the Final Office Action mailed March 23, 2006 at page 3 that: “Page 4, line 19 simply states that the optical bodies of the present invention can be used as window and auto glass films but fails to disclose a

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window film of a cast, oriented polyester-containing polymer material having a thickness of 0.3 to 3 mm.” Applicant respectfully disagrees, based at least upon the portions of the specification described above. More specifically, since an oriented polyester-containing polymer material having a thickness of 0.3 to 3 mm is clearly a disclosed “optical body of the present invention,” then the quoted passage at least inherently enables this same structure as a window film.

It is respectfully submitted that the specification reasonably conveys to skilled artisans that the applicant had possession of the claimed window film subject matter at the time the application was filed. It is believed that the record demonstrates that the written description requirement under 35 U.S.C. § 112, first paragraph, is satisfied. For at least this reason, it is respectfully requested that the rejections to claims 26 and 27 under 35 U.S.C. § 112, first paragraph, be withdrawn. Because no other rejections to claims 26 and 27 were identified, it is respectfully submitted that claims 26 and 27 are in condition for allowance.

**Claim Rejections under 35 U.S.C. §§ 102 and 103**

Claims 1, 2, 10, 11, 13-19, 21, 24, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by McGurran.

The Office Action takes the position at page 8, lines 4-7 that: “Although McGurran uses the term ‘pigment’ for indanthrone, copper phthalocyanine, and cobalt aluminate these are the same ‘dyes’ used in the instant invention and hence are inherently the same.” Applicant respectfully disagrees, and re-asserts that a “pigment” is not a “dye,” such that all claims are allowable over McGurran. One of skill in the art understands that a pigment is fundamentally different from a dye.

Applicant further traverses the rejections of claims 1, 2, 10, 11, 13-19, 21, 24, and 25 under 35 U.S.C. § 102(e) as being anticipated by McGurran because the portions of McGurran cited by the Examiner are applicant’s own work. M.P.E.P. § 2132.01; M.P.E.P. § 2136.05.

With this Response, a Declaration of Daniel J. McGurran under Rule 132 is submitted (two pages, paragraphs 1-5), confirming that the portions of McGurran cited by the Examiner are Applicant McGurran’s own work. Thus, it is respectfully submitted that the portions of

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McGurran relied upon by the Examiner do not qualify as prior art under 35 U.S.C. § 102(e). *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); M.P.E.P. § 2136.05.

Based upon the above, it is respectfully requested that the rejections to claims 1, 2, 10, 11, 13-19, 21, 24, and 25 under 35 U.S.C. § 102(e) as being anticipated by McGurran be withdrawn, and claims 1, 2, 10, 11, 13-19, 21, 24, and 25 be allowed.

Claims 22 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over McGurran in view of Weaver. As a point of reference, claim 22 depends from independent claim 1, and claim 23 depends from independent claim 14. For at least the reason that the portions of McGurran relied upon by the Examiner do not qualify as prior art under 35 U.S.C. § 102(e), then, it is respectfully submitted that claims 22 and 23 are allowable.

In addition, it is respectfully submitted that pursuant to 35 U.S.C. §103(c), McGurran does not qualify as prior art for an obviousness rejection. To this end, reference is made to the "Statement of Common Ownership" that was submitted in the Response of January 5, 2006, which forms the basis under the cited statute for eliminating McGurran as prior art for an obviousness rejection.

It is respectfully requested that the rejections to claims 22 and 23 under 35 U.S.C. §103(a) as unpatentable over McGurran in view of Weaver be withdrawn, and claims 22 and 23 allowed.

### **CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1, 2, 10, 11, 13-19, and 21-27 are in form for allowance. Notice of the allowance of claims 1, 2, 10, 11, 13-19; and 21-27 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h),(i) for the addition of claims. However, if other fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

Any inquiry regarding this Response should be directed to David B. Patchett at Telephone No. (651) 736-4713, Facsimile No. (651) 736-3833, or Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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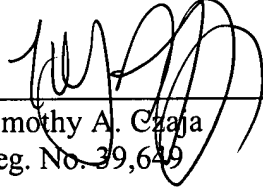
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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15<sup>th</sup> day of June, 2006.

By:   
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